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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,496	03/15/2005	Georg Ignatius	IGNATIUS	4527

20151 7590 09/02/2009  
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EXAMINER
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PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

NOTIFICATION DATE	DELIVERY MODE
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09/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,496	<b>Applicant(s)</b> IGNATIUS, GEORG	
	<b>Examiner</b> William M. Pierce	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-39, 41-43 and 46-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-39, 41-43, and 46-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 35-39, 41-43, and 46-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims now recite that the “centers” of the active elements are uniformly spaced and that they follow a harmonic series. Such is not disclosed in the specification or the drawings. A review of the specification does not even show a discussion of the center of the active elements.

### ***Claim Rejections - 35 USC § 102***

The rejection of claims 35-39, 42, 43, 46 and 48 under 35 U.S.C. 102(e) as being anticipated by Wright has not been sustained in view of applicant's amendments pertaining to the center of the active elements.

Claims 35-39, 42, 43, 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Monette 5,683,308 as set forth in the previous office action;

“As to claim 35, 37-39, 42 and 48, active elements 40 are considered to be arranged between a first end and second end uniformly spaces where 42 is considered to be the adjacent end. As to claim 36, a second harmonic series is considered show by active elements 40 as called for by claim 36. Claim 43 is considered inherent in Monette where the disks 40 are made of rubber (col, 3, ln. 19) which can be granular. See 4,031,302 by way of example.

Art Unit: 3711

As to claim 46, the selection of a material to take advantage of its known properties has been held to be obvious. To have replace the rubber in the discs 40 and 42 of Monette would have been obvious to modify the vibrational response of the shaft. Applicant has not shown where the selection of metal solved any particular problem or produces any unexpected results."

### ***Claim Rejections - 35 USC § 103***

Claims 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monette in view of Yamaguchi 4,928,965 as set forth in the previous office action;

"The applications of vibration modification techniques from one type of sport device to another is well known. See Yamaguchi 4,928,965 who teaches that such designing techniques can be used on a bat, club, racket or paddle for an example."

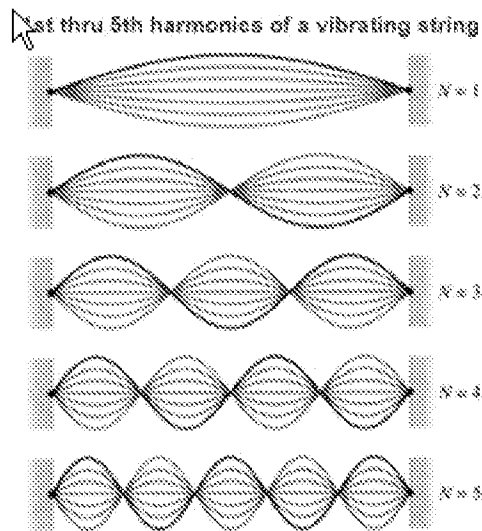
### ***Conclusion***

Applicant's arguments filed 6/22/09 have been fully considered but they are not persuasive.

Applicant argues that Monette does not specify that the center of his active elements (discs) follow a harmonic series  $1/n$ . Monette is concerned with attenuating "certain frequencies of vibration" (col. 1, ln. 66). To deal with these vibrations and to enhance the feel of the club he spaces discs evenly along the shaft as shown in his fig.

1. Here a harmonic series is generally accepted as an evenly spaced wave as shown in the fig. below;

Art Unit: 3711



Here where Monette recognizes that created are “many vibrational modes in a golf club shaft” (col. 1, ln. 42). He places his active elements based on ‘feel’. This placement is the same concern of applicant who places his active elements due to vibrations “transferred...to the hand and/or arm of the player” (spec., pg. 1, ln. 17) actuating part and what is “sensed by the player” (spec., pg. 2, ln. 3). As such, it is considered inherent that the discs of Monette “follows” a harmonic series. It is further noted that “the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email, such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample authorization form which may be used by applicant:

*"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."*

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 3711

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711